

**Claims 1-19 and 27-30 have been rejected under 35 U.S.C. 103(a) as unpatentable over Moody in view of Ornstein.**

It is asserted that Moody teaches all limitations of these claims, except for teaching payment for a parlay or consecutive winning on hands. It is asserted that Ornstein teaches “wagering and enhanced paying on consecutive winnings on hands” and that it would therefore be obvious to provide enhanced payoff by allowing parlay bets.

**RESPONSE TO THE REJECTIONS**

**Claims 22-30 have been finally rejected under 35 U.S.C. 112, second paragraph.**

It is asserted that these claims are indefinite in failing to particularly point out and distinctly claim the subject matter that Applicant regards as invention. In particular, it is asserted that in claims 22 and 23 the terms:

Placing “at least a part bet”

Playing a “second wagering” game, and

Without placing a “further” wager

are “conflicting and confusing limitations.” The rejection asserts that the claim language “does not clearly indicate that a second wager (at least a part bet!) Is not being placed for a second game.” This rejection is respectfully traversed.

To begin with, the claim and the relevant limitations has been only partially quoted, thereby creating some of the problems of interpretation that have been imposed on the claims. An excerpted and interpreted claim 22 is provided below to show how the claim is clearly understandable, with emphasis being given to those portions of the claims that have been considered in the rejection.

A method of playing a wagering game [that includes the steps of]  
comprising:

placing at least a one part bet; [NOTE – THE LANGUAGE IS AN “at least a one part bet” NOT MERELY “A PART BET” AS STATED IN THE REJECTION]

playing a first wagering game segment whose game outcome depends at least in part upon the random selection of game symbols;

comparing a first segment game outcome to the rules of the game to determine if a payout is associated with the first segment game outcome;

**playing at least a second wagering game segment whose outcome depends at least in part upon the random selection of game symbols without placing further wagers;** [THIS LANGUAGE IS CLEAR ON ITS FACE. THIS LIMITATION ABSOLUTELY REQUIRES THAT THE SECOND WAGERING GAME SEGMENT IS PLAYED “without placing further wagers” THE FURTHER WAGER IS RELATIVE TO THE LIMITATION THAT AN AT LEAST ONE PART WAGER HAS ALREADY BEEN MADE IN THE FIRST STEP OF THE CLAIM. THE LIMITATION CANNOT BE AMBIGUOUS OR INDEFINITE. THE LIMITATION IS ABSOLUTE AND THERE IS NO POSSIBLE ALTERNATIVE INTERPRETATION. THIS LIMITATION IS FURTHER REINFORCED, EVEN THOUGH NOT NEEDED, IN THE LAST LIMITATION OF THIS CLAIM.] and

comparing a second segment game outcome to the rules of the game to determine if a payout is associated with the second segment game outcome

awarding the player a first payout when the first segment game outcome is determined to be a winning outcome;

awarding the player a second payout when the at least a second game outcome is determined to be a winning outcome; and

when consecutively played first and at least second game segments both have winning outcomes, paying the player a third payout for the consecutive winning outcomes **without having placed further wagers other than the at least a one part bet.** [THIS LIMITATION AGAIN, CONTRARY TO THE ASSERTION IN THE OFFICE ACTION, ABSOLUTELY LIMITS AGAINST ANY WAGERS BEYOND THE “at least a one part bet.” THERE IS NO REASONABLE BASIS FOR ASSERTING THAT THE LANGUAGE IS IN ANY WAY AMBIGUOUS.

Based upon this limitation-by-limitation analysis, it is absolutely clear that the claim is in full compliance with 35 U.S.C. 112, second paragraph. Not only does the language clearly state the practice of the invention, but also the language is not capable of any interpretation other than that provided above. When claim language is capable of only a single interpretation, that claim cannot be indefinite under 35 U.S.C. 112, second paragraph. The rejection is clearly in error and must be withdrawn.

#### **The Rejection under 35 U.S.C. 102(b) over Netley**

The rejection of claims 20-26 under 35 USC 102(b) asserts that Netley shows a method of playing a poker game comprising the steps of wagering for each game (column 3, lines 13-14), playing at least two games (abstract), being allowed to play a second game if the player wins the first game (column 2, lines 65-67), awards being available for each of the two hands (column 3, lines 27-31) and a bonus (column 5, line 39). This rejection is respectfully traversed.

Claim 20 originally described the placement of a first wager (that is an at least one part wager) and did not require the placement of further wagers or placing winnings at risk to play the second game. That fact has been further clarified in the claims. Netley requires that a second wager be placed after winning the first hand, which includes putting a portion of the winnings from the first hand at risk. Netley does not teach the placement of a least first bet (of at least one part) and then providing the player with the opportunity (not merely an option which must be exercised by an additional wager)

“...to play a second game of poker without placing further wagers;...”

That is a substantively different format of play recited in the claims than is taught by Netley. This limitation means that after the at least one part bet (this term allows a single wager, a two part wager on the first and second game, and a triple part wager on the first, second and bonus play, **all placed at the same time**), the player may play the second game without being able to place another wager. Netley appears to require the placing of a second wager (either as a separate bet or as part of the original winning **payout** in the play of the first game) after winning the play of the first game. This step of Netley **requiring an additional wager in order to play additional games** is excluded by the recitation of claim 20. Therefore the rejection of claims 20-26 under 35 U.S.C. 102(b) over Netley is clearly in error.

### **The Rejection under 35 U.S.C. 102(b) over Ornstein**

Ornstein fails to anticipate the present invention. The present claims 20-26 require (through limitation e) in claim 20) that:

- e) “...if the player attains a hand in the second game of poker that also exceeds said predetermined rank, **a payout is achieved for a) the rank of the first poker hand, b) the rank of the second poker hand, and c) the occurrence of both the first poker hand and the second poker hand exceeding a specific rank.**

Ornstein pays for winning the first hand and then pays a bonus for winning the consecutive number of games wagered upon. There is no payoff merely for winning a second game on an original wager. As with Netley, Ornstein specifically states that **subsequent game wagers are placed at the start of each game, after conclusion (and winning) of the first game.** Note especially claim 1, and in particular, step (i) in which step (b) (“...the player making a conventional bet of a denomination within the denomination range permitted by rules of the game...”) is repeated ***after*** winning the first hand. This requires that a new wager be placed on the basic game after each win. This is specifically excluded from play of the present game, as noted above in the discussion with respect to Netley.

Additionally, there is no specific disclosure of the method of play by Ornstein in a poker variant of the game. There is therefore no basis for anticipation of the limitation regarding awarding wins on the basis of predetermined ranks of poker hands. That teaching is absent from Ornstein, and therefore Ornstein cannot anticipate claims 20-26.

The rejection of claims 20-26 under 35 U.S.C. 102(b) over both Netley and Ornstein is clearly in error and must be withdrawn.

### **Claims 1-19 and 27-30 have been rejected under 35 U.S.C. 103(a) as unpatentable over Moody in view of Ornstein.**

In addition to the fatal defects noted above with respect to Ornstein alone, Moody adds even further differences from the present invention so that even if the references are combined, they do not provide teachings of the present invention.

To begin with, Moody does not teach consecutive games in which play of second, third, etc. games are dependent upon the winning of a first hand. Moody teaches the play of multiple games simultaneously. Note column 1, lines 29-42 where cards are duplicated among

contemporaneously disclosed hands, cards are dealt to multiple rows on the screen, and players are independently paid for individual winning hands. The underlying concept of Moody is quite different from that recited in the present claims. **There is no continuation of a first bet from a first game to a subsequent and distinct wagering game as required in the claims of this Application.**

Combining Moody with Ornstein severely changes the play of Moody, yet no direction or motivation is provided to change that game to the type of game recited in the claims of this Application. As noted above, Ornstein does not teach the placement of at least a single wager at the beginning of the game that is used with regard to initial game play, second game play, and bonus payouts. It is therefore unreasonable to assume that the combination of Moody and Ornstein can establish as obvious that method of game play. This is particularly the case where, as here, Moody does not even show consecutive games, play of games dependent upon success with previous games, and the award of bonuses for consecutive play. As Moody fails to show these features (even though Ornstein does show bonuses for multiple wins), it is impossible for Moody to overcome the deficiencies noted in the discussion of Ornstein. The combination of references fails to teach the invention as claimed.

It is to be noted that even though claims 1 and 15 were not amended as was claim 20, claims 1 and 15 specifically describe play as including:

“**..resolving the at least one bet with respect to** whether a) the first set of symbols and the second set of symbols exceed a minimum rank in the payout table; b) the second set of symbols exceeds a minimum rank in the payout table; **and** c) first set of symbols and the second set of symbols exceed a minimum rank in the payout table.”

*(emphasis added)*

This limitation requires that the at least first wager placed before receiving all of the first set of symbols is resolved with respect to play of the second set of symbols and the relative rank of both hands.

It is clear that this rejection is in error and that all rejections should be withdrawn and all claims should be allowed.

**CONCLUSION**

All claims under prosecution are in condition for allowance.

The Examiner is invited to telephone Applicant's below-listed representative at (952) 832.9090 to facilitate prosecution of this application.

Respectfully submitted,

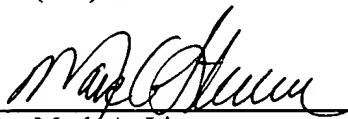
MARK YOSELOFF

By His Representatives,

Mark A. Litman  
York Business Center, Suite 205  
3209 West 76<sup>th</sup> Street  
Edina, MN 55435  
(952)832.9090

Date January 28, 2002

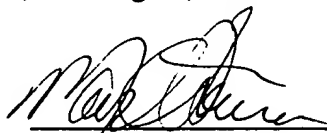
By

  
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Mark A. Litman

Reg. No. 26,390

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to BOX AF (AMENDMENT AFTER FINAL), Assistant Commissioner of Patents, Washington, D.C. 20231 on **January 28, 2002.**

Name: Mark A. Litman

  
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